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APR 26 2005

OFFICE OF PETITIONS

In re Application of	:	
Erwin Spanner	:	
Application No. 09/661,663	:	DECISION ON APPLICATION
Filed: September 14, 2000	:	FOR
Attorney Docket No. 56/344	:	PATENT TERM ADJUSTMENT
	:	

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. § 1.705(b)," filed September 30, 2004. Applicant requests that the determination of patent term adjustment indicated in the notice of allowance be corrected from fifty-seven (57) to three hundred thirty (330) days.

The application for patent term adjustment is **DISMISSED**. However, for the reasons stated herein, the patent term adjustment indicated in the notice of allowance is being corrected to ninety (90) days.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is ninety (90) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On June 30, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment

to date is 57 days. On September 30, 2004, applicant timely submitted this application for patent term adjustment¹.

Applicant asserts that a period of adjustment of two hundred forty (240) days, pursuant to § 1.703(a)(6), should be entered. Specifically, applicant requests this period of adjustment to reflect the "4 month" delay from applicant's filing of the issue fee on December 23, 2002 to December 19, 2003 (the date of filing of a petition to withdraw from issue), wherein a patent had still not been issued (the number of days in the period from April 23, 2003 to December 19, 2003).

Applicant states that the present application is not subject to a terminal disclaimer.

Applicant's arguments have been considered, but not found persuasive. 37 CFR § 1.702(a)(4) provides that:

subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent not later than four months after the date on which the issue fee was paid under 35 U.S.C. 151 and all outstanding requirements were satisfied.

Section 1.703(a)(6) pertains to the provisions of 35 U.S.C. 154(b)(1)(A)(iv) and § 1.702(a)(4). Section 1.703(a)(6) specifies that:

the period is the number of days, if any, beginning on the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date the patent was issued.

As stated in the final rule:

the date the issue fee was paid and all outstanding requirements were satisfied is the later of the date the issue fee was paid or the date all outstanding requirements were satisfied. However, if prosecution in an application is reopened after allowance (see MPEP 1308), all

¹ Palm Records indicate that the Issue Fee payment was also received on September 30, 2004.

outstanding requirements are not satisfied until the application is again in condition for allowance as indicated by the issuance of a new notice of allowance under 35 U.S.C. 151 (see MPEP 1308). See *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000).

Accordingly, in this instance, the date of payment of the issue fee is not controlling. After payment of the issue fee, prosecution was reopened with the filing of a request for continued examination filed December 15, 2003.

However, a review of the application history reveals that the reduction of 68 days for applicant delay in responding to the Office action mailed March 19, 2002 is incorrect. The Office action was remailed and the period for reply restarted on April 22, 2002. Thus, pursuant to § 1.704(b), the period of reduction is 35 days for the period beginning on the day after the date that is three months after the date of remailing of the Office action, July 23, 2002, and ending on the date the reply was filed, August 26, 2002.

In view thereof, the determination of Patent Term Adjustment at the time of mailing of the notice of allowance of ninety (90) days (125 - 35).

Applicant's submission of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged.

The application file is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

Karin Ferriter
per

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of REVISED PAIR Screen